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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,420	06/23/2003	Tomohiko Kikuchi	WISEL 20.401	1990
26304	7590	10/03/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			DANIELSEN, NATHAN ANDREW	
			ART UNIT	PAPER NUMBER
			2627	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,420	<b>Applicant(s)</b> KIKUCHI, TOMOHIKO	
	<b>Examiner</b> Nathan Danielsen	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-5 are pending.

#### *Claim Objections*

2. Claims 2 and 4 are objected to because of the following informalities: the examiner suggests changing "comprising" to --comprises-- or --further comprises--. Claim 2 is further objected to because Applicant has removed the phrase "or a disk similar thereto" from claim 4 and should do the same in claim 2. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation "wherein said rotation detecting apparatus does not require a specialized disk for said detecting" is considered new matter as Applicant's specification only sets forth what information the analog record contains but fails to exclude any other information.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 is rejected as being indefinite because it is unclear in light of the specification exactly what "a specialized disk" is defined to be. The examiner recommends that the limitation quoted above be amended in the following manner in order to overcome both of these 35 U.S.C. § 112 rejections:

--wherein said rotation detecting apparatus does not require a specialized disk, other than what is typically used with said analog record player, for said detecting--.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Spencer (US Patent 6,881,949).

9. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Regarding claim 1, Spencer discloses a digital audio data reproducing system comprising:

a digital audio data reproducing apparatus including a recording medium in which digital audio data are stored, detection means for detecting the digital audio data stored in said recording medium and a processing section for reproducing said digital audio data in accordance with a reproducing speed signal and a reproducing direction signal which are supplied from the outside to said detection means (col. 3, lines 9-15);

an analog record player including a turntable for an analog record or a disk similar thereto and rotation driving means for said turntable (figures 2-4 and 6); and

a rotation detecting apparatus mounted onto said analog record player for detecting both the speed of revolution and the sense of rotation for either said turntable or said analog

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record or a disk similar thereto, which is rotated by said turntable, and for supplying said reproducing speed signal and said reproducing direction signal to said digital audio data reproducing apparatus, after determining said reproducing speed signal and said reproducing direction signal from the detection signals for the speed of revolution and the sense of rotation (col. 5, line 45 through col. 6, line 20 and lines 46-52 and figures 3A-3D);

wherein said rotation detecting apparatus does not require a specialized disk, other than what is typically used with said analog record player, for said detecting (col. 3, lines 9-15).

Regarding claim 2, Spencer discloses a digital audio data reproducing system according to claim 1, wherein said rotation detection apparatus comprises:

a rotation body which is rotated by either said turntable or said analog record in contact therewith (figures 3A-3D and related disclosure); and

a rotary encoder including an encoder disk connected to a rotary shaft of said rotation body and a photoelectric detector for sensing said encoder disk (col. 5, lines 15-21 (for a description of encoders that can be used in the invention of Spencer) and figures 3A-3D and related disclosure).

Regarding claim 4, Spencer discloses a digital audio data reproducing system according to claim 1, wherein said rotation detecting apparatus comprising:

an image sensor for reading the surface of said analog record as image data (col. 6, lines 21-31); and

a processing unit for determining said reproducing speed signal and said reproducing direction signal to be output on the basis of said image data supplied from said image sensor (col. 6, lines 21-31).

Regarding claim 5, Spencer discloses a digital audio data reproducing system according to claim 4, wherein said rotation detecting apparatus is further equipped with switch means for transmitting/interrupting said reproducing speed signal and said reproducing direction signal to said digital

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audio data reproducing apparatus by the operation of an operator at the output of said processing unit in said rotation detecting apparatus (suggested by col. 4, lines 18-29 and col. 5, lines 31-45).

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,898,165 (hereinafter Kikuchi '165) in view of Spencer.

Regarding claim 1, Kikuchi '165 claims a reproducing system comprising:

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a reproducing apparatus including a recording medium, detection means for detecting audio data, and a processing section for reproducing said audio data;  
an analog record player including a turntable and rotation driving means for said turntable; and  
a rotation detecting apparatus which is rotated by said turntable and supplies a reproducing speed signal and a reproducing direction signal to said audio data reproducing apparatus  
(all limitations found in claim 1).

However, Kikuchi '165 does not claim where the reproducing apparatus reproduces *digital* audio data from a *digital* recording medium.

In the same field of endeavor, Spencer discloses an apparatus for providing a user with control over audio and video digital media via an analog control unit capable of playing existing vinyl records. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have controlled digital audio reproduction by manipulating a vinyl record, as taught by Spencer, for the purpose of synchronizing a vinyl record with a digital source (col. 1, lines 57-64).

Regarding claim 2, Kikuchi '165 claims a digital audio data reproducing system according to claim 1, wherein said rotation detection apparatus comprises:

a rotation body which is rotated by either said turntable or said analog record or a disk similar thereto in contact therewith; and  
a rotary encoder including an encoder disk connected to a rotary shaft of said rotation body and a photoelectric detector for sensing said encoder disk (all limitations claimed and described in claims 1 and 4).

#### ***Allowable Subject Matter***

12. Claim 3 is allowed for the reasons indicated in the Office action mailed 24 May 2006.

#### ***Response to Arguments***

13. Applicant's arguments with respect to the rejection of claims 1, 2, 4, and 5 under 35 U.S.C. 102(b) have been considered but are moot in view of the new ground(s) of rejection.

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14. Applicant's arguments with respect to the rejection of claims 1 and 2 under the judicially created doctrine of obvious-type double patenting are not persuasive. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Closing Remarks/Comments***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Danielsen whose telephone number is (571) 272-4248. The examiner can normally be reached on Monday-Friday, 8:30 AM - 4:30 PM Eastern Time.

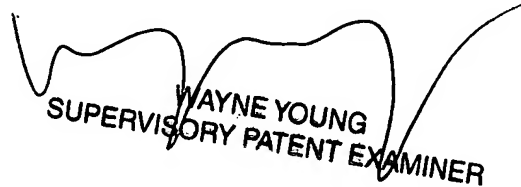
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A.L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nathan Danielsen  
09/26/2006



WAYNE YOUNG  
SUPERVISORY PATENT EXAMINER